



PATENT

DAE
JhaIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: David B. Kita, et al. Serial No.: 10/692,286 Filed: October 23, 2003 Title: Efficient Use of Keyframes in Video Compression	Examiner: not yet known Art Unit: 2621 Atty. Docket No.: 10006.001610
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Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.47(a)

Sir:

This is being filed in response to the Decision Refusing Status Under 37 CFR 1.47(a) (the Decision) mailed April 30, 2004 with respect to the above-referenced patent application. Enclosed is a copy of the Decision.

Further communications with the previously nonsigning inventor, Mr. David Kita, have been made. Mr. Kita decided to finally agree to sign the Declaration, Power of Attorney, and Assignment documents. The Declaration and Power of Attorney as executed by Mr. Kita are being submitted to the patent office today. Enclosed please find a copy of the "Submission of Executed Declaration and Power of Attorney from Previously Nonsigning Inventor," including a copy of the executed documents.

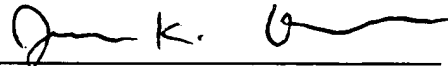
Applicants respectfully submit that the submission of the signed Declaration and Power of Attorney by Mr. Kita completes the present application filing and either satisfies or renders moot the petition at issue.

If the Examiner has any questions or needs additional information, the Examiner is invited to contact the undersigned attorney at (408) 436-2110.

Dated: June 23, 2004

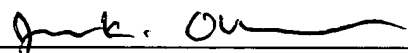
Respectfully submitted,

David B. Kita, et al.

By: 

James K. Okamoto
Attorney For Applicant(s)
Reg. No. 40,110
OKAMOTO & BENEDICTO LLP
P.O. Box 641330
San Jose, California 95164
(408) 436-2110
(408) 436-2114 (FAX)

Enclosure(s)

CERTIFICATE OF MAILING			
I hereby certify that this correspondence, including the enclosures identified herein, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below. If the Express Mail Mailing Number is filled in below, then this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service pursuant to 37 CFR 1.10.			
Signature:			
Typed or Printed Name:	James K. Okamoto	Dated:	June 23, 2004
Express Mail Mailing Number (optional):			



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

OKAMOTO & BENEDICTO, LLP
P.O. BOX 641330
SAN JOSE, CA 95164

COPY MAILED

APR 30 2004

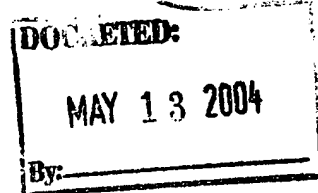
In re Application of
Kita, Yang, and Selegue
Application No. 10/692,286
Filed: October 23, 2003
Attorney Docket No. 10006.001610
For: EFFICIENT USE OF KEYFRAMES IN
VIDEO COMPRESSION

OFFICE OF PETITIONS

:
:
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
:

This is a decision on the petition under 37 CFR 1.47(a) filed March 22, 2004.

The petition under 37 CFR 1.47(a) is **dismissed**.



Any request for reconsideration under this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Failure to respond will result in the abandonment of this application. Any response should be titled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)".

The above-identified application was filed on October 23, 2003, without a proper oath or declaration. Accordingly, a "Notice to File Missing Parts of Nonprovisional Application" was mailed on January 27, 2004, requiring payment of the filing fee, an executed oath or declaration, and a surcharge for the late filing of the oath or declaration.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee,
- (4) a statement of the last known address of the non-signing inventor,

The instant petition lacks item (1) as set forth above.

As to item (1), petitioner has not established that the non-signing inventor cannot be reached or has constructively refused to sign the oath or declaration. Petitioner has only indicated that a copy of the application papers and declaration was sent to the last known address of the non-signing inventor. There is no indication that the papers were received. If petitioner is arguing that the non-signing inventor is

unavailable to join the prosecution of the application, section 409.03(d) of the *Manual of Patent Examining Procedure* (MPEP) explains that:

[w]here inability to find or reach a non-signing inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts, which are relied on to establish that a diligent effort was made.

It cannot be concluded that petitioner made a 'diligent' effort to locate the non-signing inventor given the evidence presented. It is only clear that the application papers were sent to the last known address of the non-signing inventor ; this, without more, does not amount to diligence in locating the non-signing inventor. Section 409.03(d) further explains that the aforementioned statement "... must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence, such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the non-signing inventor could not be found or reached should be made part of the statement." In this case, petitioner should, at least, provide some evidence that the non-signing inventor has received the application papers, i.e., a certified mail return receipt, or that other efforts were made to locate the non-signing inventor to no avail.

If petitioner is maintaining that the non-signing inventor has constructively refused to join the application, petitioner must provide some evidence that the non-signing inventor has received the application papers, but is unwilling to comply as demonstrated by inventor's behavior either expressly or constructively.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents,
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

Telephone inquiries should be directed to the undersigned (703) 305-0010.



Kenya A. McLaughlin
Petitions Attorney
Office of Petitions



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: David B. Kita, et al. Serial No.: 10/692,286 Filed: October 23, 2003 Title: Efficient Use of Keyframes in Video Compression	Examiner: not yet known Art Unit: 2621 Atty. Docket No.: 10006.001610
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUBMISSION OF EXECUTED DECLARATION AND POWER OF ATTORNEY
FROM PREVIOUSLY NONSIGNING INVENTOR

Sir:

Please find enclosed a "Declaration for Utility or Design Patent Application" (the Declaration) as executed by David B. Kita. Please also find enclosed a "Power of Attorney and Correspondence Address Indication Form" as executed by Mr. Kita. We had previously submitted a Petition under 37 C.F.R. 1.47(a) for Mr. Kita.

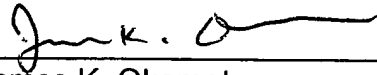
The Declaration and powers of attorney as executed by the other co-inventors has been previously submitted.

If the Examiner has any questions or needs additional information, the Examiner is invited to contact the undersigned attorney at (408) 436-2110.

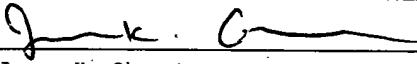
Dated: June 23, 2004

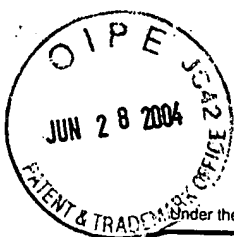
Respectfully submitted,

David B. Kita, et al.

By: 
James K. Okamoto
Attorney For Applicant(s)
Reg. No. 40,110
OKAMOTO & BENEDICTO LLP
P.O. Box 641330
San Jose, California 95164
(408) 436-2110
(408) 436-2114 (FAX)

Enclosure(s)

CERTIFICATE OF MAILING			
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Signature:			
Typed or Printed Name:	James K. Okamoto	Dated:	June 23, 2004
Express Mail Mailing Number (optional):			



**DECLARATION FOR UTILITY OR
DESIGN
PATENT APPLICATION
(37 CFR 1.63)**

☐ Declaration Submitted With Initial Filing OR ☒ Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16 (e)) required)

Attorney Docket Number 10006.001610

First Named Inventor David B. Kita

COMPLETE IF KNOWN

Application Number 10/692,286

Filing Date October 23, 2003

Art Unit 2621

Examiner Name not yet known

I hereby declare that:

Each inventor's residence, mailing address, and citizenship are as stated below next to their name.

I believe the inventor(s) named below to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

EFFICIENT USE OF KEYFRAMES IN VIDEO COMPRESSION

the specification of which (Title of the Invention)

☐ is attached hereto

OR

☒ was filed on (MM/DD/YYYY)

10/23/2003

as United States Application Number or PCT International

Application Number

10/692,286

and was amended on (MM/DD/YYYY)

(if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY) Country	Priority Not Claimed	Certified Copy Attached?	
				YES	NO
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto:

[Page 1 of 2]

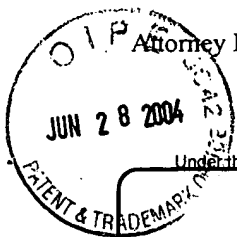
This collection of information is required by 37 CFR 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION — Utility or Design Patent Application

Direct all correspondence to: <input checked="" type="checkbox"/> Customer Number or Bar Code Label		000031894		OR <input type="checkbox"/> Correspondence address below	
Name					
Address					
City		State		ZIP	
Country		Telephone		Fax	
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.					
NAME OF SOLE OR FIRST INVENTOR:		<input type="checkbox"/> A petition has been filed for this unsigned inventor			
Given Name (first and middle [if any])		David B.		Family Name or Surname	
				Kita	
Inventor's Signature		<i>David Kita</i>		Date	
				5/30/04	
Residence: City		State		Country	
Milpitas		CA		US	
Citizenship		US			
Mailing Address					
1674 Grand Teton Drive					
City		State		Country	
Milpitas		CA		US	
Zip		95035			
NAME OF SECOND INVENTOR:		<input type="checkbox"/> A petition has been filed for this unsigned inventor			
Given Name (first and middle [if any])		Tser-Yuan Brian		Family Name or Surname	
				Yang	
Inventor's Signature				Date	
Residence: City		State		Country	
Livermore		CA		US	
Citizenship		US			
Mailing Address					
887 Waverly Common					
City		State		Country	
Livermore		CA		US	
Zip		94551			
<input checked="" type="checkbox"/> Additional inventors or a legal representative are being named on the 1 supplemental sheet(s) PTO/SB/02A or 02LR attached hereto.					



Attorney Docket No.: 10006.001610

PTO/SB/02A (08-03)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION**ADDITIONAL INVENTOR(S)
Supplemental Sheet**

Page 1 of 1

Name of Additional Inventor, if any		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Dylan		SeLeque	
Inventor's Signature		Date	
Residence: City	Milpitas	State	CA
Country	US	Citizenship	US
Mailing Address 1455 E. Calaveras Blvd. #15			
City	Milpitas	State	CA
ZIP	95035	Country	US
Name of Additional Inventor, if any		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Inventor's Signature		Date	
Residence: City		State	
Country		Citizenship	
Mailing Address			
City		State	
Zip		Country	
Name of Additional Inventor, if any		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Inventor's Signature		Date	
Residence: City		State	
Country		Citizenship	
Mailing Address			
City		State	
Zip		Country	

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/692,286	
	Filing Date	October 23, 2003	
	First Named Inventor	David B. Kita	
	Art Unit	2621	
	Examiner Name	not yet known	
Total Number of Pages in This Submission	11	Attorney Docket Number	10006.001610

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Request for Reconsideration under 37 CFR 1.47(a); Copy of Decision Refusing Status under 37 CFR 1.47(a); Copy of Submission of Executed Declaration and Power of Attorney from previously Nonsigning Inventor, signed Declaration and Power of Attorney filed 06/23/04; Return receipt postcard
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	James K. Okamoto, Reg No. 40,110 OKAMOTO & BENEDICTO LLP
Signature	
Date	June 23, 2004

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	James K. Okamoto		
Signature		Date	June 23, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



**POWER OF ATTORNEY
and
CORRESPONDENCE ADDRESS
INDICATION FORM**

Application Number	10/692,286
Filing Date	October 23, 2003
First Named Inventor	David B. Kita
Art Unit	2621
Examiner Name	not yet known
Attorney Docket Number	10006.001610

I hereby appoint:

☒ Practitioners at Customer Number

000031894

OR

☐ Practitioner(s) named below:

Name	Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the Patent and Trademark Office connected therewith.

Please recognize or change the correspondence address for the above-identified application to:

☒ The above-mentioned Customer Number:

OR

☐ The address associated with Customer Number:

OR

☐ Firm or
Individual Name

Address

Address

City

State

ZIP

Country

Telephone

Fax

I am the:

☒ Applicant/Inventor.

☐ Assignee of record of the entire interest. See 37 CFR 3.71.

Certificate under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).

SIGNATURE of Applicant or Assignee of Record

Name

David B. Kita

Signature

Date

5/30/04

Telephone

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 3 forms are submitted.

This collection of information is required by 37 CFR 1.31 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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